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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,795	02/28/2002	Mutsuyuki Okayama	2002-0292A	3873

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EXAMINER

WINTER, JOHN M

ART UNIT

PAPER NUMBER

3621

DATE MAILED: 10/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/069,795	<b>Applicant(s)</b> OKAYAMA ET AL.	
	<b>Examiner</b> John M. Winter	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 13-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 13-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-12 are drawn to content protection with an intermediate key, classified in class 705 subclass 51.
  - II. Claims 13-16 are drawn to processing with an identification signal, classified in class 705 subclass 50.
  - III. Claims 17-19 are drawn to a processing a signal, classified in class 713 subclass 1.

Inventions I, II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed in invention I does not require the particulars of the subcombination as claimed in inventions II or III such as an identification signal or a heading pattern detection means.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Examiner notes that it would be a burden to search multiple inventions given their separate status in the art as noted above.

The requirement is deemed proper and therefore made FINAL.

Via the paper filed on July 27, 2006 the applicant has elected the examination of invention II directed towards claims 13-16. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-12 and 17-19 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### **STATUS**

Claims 13-16 remain pending .

***Response to Arguments***

The Applicants arguments filed on July 27, 2006 have been fully considered. The amended claims are rejected in view of the newly discovered reference Schenck et al. (US Patent 6,314,409) in view of Maytas et al (US Patent 5,200,999). See following rejection.

***Claim Rejections - 35 USC § 102***

The following is a quotation of 35 U.S.C. 102(b) which forms the basis for all obviousness rejections set forth in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 13 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneck et al. (US Patent 6,314,409).

As per claim 13,

Schneck et al. ('409) discloses a copyright protective device for encrypting or decrypting a content, comprising:

key generation means for generating a key with which to apply cryptographic processing to the content (Column 14, lines 43-61) and outputting a notification signal which indicates whether key generation is being performed or not, (Figure 4)

cryptographic processing means, to which a content containing identification information indicating whether or not to perform cryptographic processing is inputted, for applying cryptographic processing to the content in accordance with the identification information by using the key,(Figure 10A)

outputting a result of the cryptographic processing, wherein the cryptographic processing means restrains the result of the cryptographic processing from being outputted when the notification signal indicates that key generation is being performed.(Figure 10A)

As per claim 14,

Schneck et al. ('409) discloses a copyright protective device for encrypting or decrypting a content, comprising:

key generation means for generating a key with which to apply cryptographic processing to the content (Column 14, lines 43-61) and outputting a notification signal which indicates whether key generation is being performed or not, (Figure 4)

cryptographic processing means, to which a content containing identification information indicating whether or not to perform cryptographic processing is inputted, for applying cryptographic processing to the content in accordance with the identification information by using the key,(Figure 10A)

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outputting a result of the cryptographic processing, wherein the cryptographic processing means restrains the result of the cryptographic processing from being outputted when the notification signal indicates that key generation is being performed.(Figure 10A)

otherwise selecting the result of the cryptographic processing outputted from the cryptographic processing means. (Figure 10A)

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 15 – 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schneck et al. (US Patent 6,314,409) in view of Maytas et al. (US Patent 5,200,999).

As per claim 15,

Schneck et al. ('409) discloses a copyright protective device for encrypting or decrypting a content, comprising:

key generation means for generating a key with which to apply cryptographic processing to the content (Column 14, lines 43-61) and outputting a notification signal which indicates whether key generation is being performed or not, (Figure 4)

cryptographic processing means, to which a content containing identification information indicating whether or not to perform cryptographic processing is inputted, for applying cryptographic processing to the content in accordance with the identification information by using the key,(Figure 10A)

outputting a result of the cryptographic processing, wherein the cryptographic processing means restrains the result of the cryptographic processing from being outputted when the notification signal indicates that key generation is being performed.(Figure 10A)

Schneck et al. ('409) does not explicitly disclose “the cryptographic processing means switches an input enable signal for controlling inputting of contents to an input disabled state” Maytas et al. ('999) discloses “the cryptographic processing means switches an input enable signal for controlling inputting of contents to an input disabled state”. (Figures 14 and 15) It would be obvious to one having ordinary skill in the art at the time the invention was made to combine the Schneck et al. ('409) method with the Maytas et al. ('999) method in order to allow the system to be unobservable in order to deter tampering.

Claim 16 is in parallel with claim 15 and is rejected for at least the same reasons.

### ***Conclusion***

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Examiners note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Winter whose telephone number is (571) 272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



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